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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,350	06/14/2002	Anne-Marie Sepulchre	004900-213	2855

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EXAMINER

HENDRICKS, KEITH D

ART UNIT PAPER NUMBER

1761

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,350

Applicant(s)

SEPULCHRE ET AL.

Examiner

Keith Hendricks

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-17 is/are pending in the application.
- 4a) Of the above claim(s) 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-16 is/are rejected.
- 7) ☒ Claim(s) 15 and 16 is/are objected to.
- 8) ☒ Claim(s) 17 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>Aug 2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

Applicant's election with traverse of Group I in the reply filed on August 30, 2004, is acknowledged. The traversal is on the ground(s) that "the inventions are clearly related, each to the other, and the Examiner is not required to insist on restriction. Applicants submit that, despite the separate classification, it would not be unduly burdensome for the Examiner to examine the related subject matter of Group II together with elected Group I." This is not found persuasive because applicants have not addressed the reasoning properly and clearly set forth in the restriction requirement, and thus have not set forth an acceptable rebuttal to the requirement. Further, applicant may not willfully presume and summarily dismiss the 'burden' or lack thereof, required by the search for the claimed invention. As previously stated in the restriction requirement, these two inventions are separately classified, and present vastly different modes and efforts of search. They are not simply two minor deviations of the same invention. One is directed to a method of making cheese, while the other is an assay method for mutant strains of bacteria.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10, the phrase "selected from the group comprising cheeses and fermented dairy products", is indefinite for several reasons. Initially, the phrase "selected from the group comprising" does not properly set forth the metes and bounds of the claimed invention, with respect to accepted U.S. Patent practice. The patent claim phrase "selected from the group consisting of" the recited elements, is an accepted phrase which indicates a closed group. Conversely, the term "comprising" is an accepted patent term which provides an open set of elements. Thus, the phrase recited in the claims does not accurately set forth the metes and bounds of the claimed invention.

Secondly in claim 10, the phrase "cheeses and fermented dairy products" sets forth an improper Markush-type set of elements, with an improper overlap between "cheeses", and "fermented dairy products." This is because cheese is a fermented dairy product, and thus the metes and bounds of the claimed invention are not properly set forth. The phrase "selected from the group consisting of cheeses and other fermented dairy products", would be an acceptable alternative to the current claim language.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Tinson et al.

Tinson et al. disclose the production of cheese, using a urease-negative strain of *Streptococcus thermophilus*. The limitations regarding the acidification kinetic, as recited in instant claims 10-13, would have been inherent properties of the disclosed method of the reference, absent any clear and convincing evidence and/or arguments to the contrary. In order to demonstrate otherwise, applicant is invited to compare the same method and results to that of the claimed invention, for example, utilizing the deposited strains recited in claims 15-16, which were mutated, produced and deposited by applicants. Regarding instant claim 14, as no seeding rate is provided by either the reference, or the instant application, with regard to the parent strain, a comparison cannot be made. However, since the independent claim limitations have been met, one of ordinary skill in the art would expect that the limitations of claim 14 would be an inherent property of the referenced method, as well.

Conclusion

Claims 15-16 are free of the prior art of record. As applicants have provided new strains which presumably differ from those known and deposited in the art, as disclosed at page 4 of the instant specification by their deposit, the use of such strains within the instantly-claimed method, is considered free of the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (571) 272-1401. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**KEITH HENDRICKS
PRIMARY EXAMINER**